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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/202,244 02/19/99 BREUNIG

S 022701-803

021839 IM62/0121
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EXAMINER

MOORE, M

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 01/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/202,244

Applicant(s)
Breunig et al.

Examiner
Margaret Glass Moore

Group Art Unit
1712



☒ Responsive to communication(s) filed on Dec 10, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 to 21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 to 21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The Examiner notes that an election of species requirement was made in this application, whereby the Examiner requested an election of a species from the synthon species as found in claim 6. During a telephone interview with Teresa Stanek Rea on January 12, 2000, an election was made with traverse to initiate prosecution with the species (IX). During a subsequent review of the claims, the Examiner noticed that applicants' claims provide an election by original presentation. Note that claim 15 is drawn to this preferred species. Thus the requirement for an election of species is now moot. Currently claims 1 to 21 are under consideration.

2. Claims 1 to 21 are objected to because of the following informalities:

The claims use improper Markush language. See M.P.E.P 2173.05(h), drawn to alternative limitations, specifically Markush groups.

In claim 2, reference to claim 1 twice is redundant.

Appropriate correction is required.

3. Claims 3, 13 to 15, 16, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3:

It is unclear what is intended by "a free valency".

Claims 13 to 15:

The phrase "which can be obtained" is indefinite since it is unclear if the silicone oil is required to be prepared by this process.

Also in claim 15, reference to formula (IX) is confusing since this is not in claim 1.

Claims 16 and 17:

A process of using the silicone oil of claim 13 is indefinite since no specific process step is claimed. Note that "using" is not a definite step and it is unclear what is encompassed by this claim.

Claim 20:

Again note that a process which comprises "using" a catalyst is indefinite since it contains no specific process steps. Also, "catalytic composition a metal comprising" does not make sense.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3 to 9, 11 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jachmann et al.

Jachmann et al. teach a reaction between a polyorganohydrosiloxane and a epoxy containing compound. See for instance Example 1 which shows a polyorganohydrosiloxane meeting formula (XVI) and a compound which corresponds to the claimed synthon, and preferred formula (IX). This example merely demonstrates the reactants which are anticipated by Jachmann et al. Patentees teach on column 8 that the catalyst can be platinum on charcoal.

Since the selection of the catalyst is from only 3 species, the genus is limited enough to anticipate the selection of platinum on charcoal support, thus anticipating the instant claims.

On the other hand, Example 1 uses a platinum catalyst that is taught as being a functional equivalent of platinum on charcoal. As such the skilled artisan would have been motivated to use a platinum on charcoal support in the process of Jachmann et al., thereby rendering obvious the instant claims.

7. Claims 13 - 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jachmann et al.

Note that the claims do not require the use of the process of claim 1 to arrive at the claimed silicone oil, only that it be able to be obtained by this process. As such the silicone oil comprising synthons as taught by Jachmann et al. anticipates this claim. As noted supra, such silicone oils can be obtained by the method of claim 1.

Furthermore, since the processes of claims 16 and 17 do not require any particular process steps, these too are anticipated by the teachings of Jachmann et al. On the other hand note that column 9 teaches that the silicones therein can be used in release coatings.

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8. Claims 2, 9, 10, 12, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jachmann et al.

With regards to claim 2, the Examiner acknowledges that patentees do not teach a carbon black support; however, she takes Official Notice that charcoal and carbon black are known to be used interchangeably as supports for platinum catalysts in hydrosilation reactions such as that in Jachmann et al. As such the skilled artisan would have found this difference to have been obvious in view of that which is known in the art.


Regarding claims 9 and 10, adjusting the amount of catalyst in the hydrosilation reaction in an effort to optimize results would have been well within routine experimentation of the teachings of Jachmann et al. for one having ordinary skill in the art. Furthermore, it would naturally follow that when using a platinum catalyst on a support, the skilled artisan would pass the reactants over or through a stationary bed of the catalyst. This is the standard means of performing a reaction when using such a catalyst.

Regarding claim 18, note that adjusting the order of addition of the reactants is well within routine experimentation for one having ordinary skill in the art and as such the skilled artisan would have found the claimed order of addition obvious over the teachings of Jachmann et al.

9. Koshar et al. is cited as being of general interest. This reference teaches a hydrosilation reaction between a "synthon" and a polyorganohydrosiloxane, but fails to use the catalyst support as required by the claims.

10. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) 305-3599. All other **official** faxes should be sent to (703) 305-5408. Please do not send any informal communication or proposed amendments to this number.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
January 14, 2000